

REMARKS

Applicants thank the Examiner for the thorough consideration given the present application. Claim 2 was previously cancelled. Claims 1 and 3-16 are pending. Claim 11 is amended, and claims 12-16 are added. Claim 1 is independent. The Examiner is respectfully requested to reconsider the rejections in view of the amendments and remarks set forth herein.

Rejection Under 35 U.S.C. § 112, first paragraph

Claim 11 stands rejected under 35 U.S.C. § 112, first paragraph. This rejection is respectfully traversed.

In order to overcome this rejection, Applicants have amended claim 11 to remove the matter allegedly not supported by the original disclosure.

Applicants respectfully submit that claim 11, as amended, is fully supported by and adequately described in the written description of the invention. Accordingly, reconsideration and withdrawal of this rejections under 35 U.S.C. 112, first paragraph are respectfully requested.

Rejection Under 35 U.S.C. § 112, second paragraph

Claim 11 stands rejected under 35 U.S.C. § 112, second paragraph. This rejection is respectfully traversed.

The Examiner has set forth certain instances wherein the claim language is not clearly understood.

In order to overcome this rejection, the Applicants have amended claim 11 to correct the deficiency specifically pointed out by the Examiner. The Applicants respectfully submit that the claims, as amended, particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejections Under 35 U.S.C. § 103(a)

Claim 1, 3, 4, 7, 8, and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Khosravi (U.S. Patent 6,361,546) in view of Brooks et al. (U.S. Patent 6,346,116);

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Khosravi in view of Brooks et al., and further in view of Rosenbluth (WO 99/56801); and

Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Khosravi in view of Brooks et al., and further in view of Boylan et al. (U.S. 6,602,272).

These rejections are respectfully traversed.

Arguments Regarding Independent Claim 1 as Previously Presented

Independent claim 1 as previously presented recites a combination of elements directed to a thrombus capture catheter, including *inter alia*

“said crossed wire member comprising a plurality of spirally-configured wires, which cross each other, thereby forming an original configuration swollen in middle portion and tapered to the proximal and distal ends thereof under a normal condition ...

said crossed wire member being fixed at the proximal end thereof to said shaft and being slidably mounted at the distal end on said shaft.”

Further support for the above subject matter can be found in FIG. 3 and paragraphs [0012] and [0037] of the original application.

Regarding Khosravi

By contrast, as can be seen in Khosravi FIG. 1 and column 4, lines 24-27, this document merely discloses “Alternatively, distal ends 28 of struts may be attached to a collar (not shown)...” that is slidable on the tubular member 12. As can be seen in FIG. 1, the struts appear to linear members which bulge along the filter material 16 when the intermediate region 32 of the filter material 16 is expanded in a radial direction.

Further as can be seen by comparing Khosravi FIGS. 1, 2A, and 2B, the distal end 36 of the filter material 16 cannot possibly be fixed to bumper member 54, which the Examiner alleges can be combined with tubular member 12 to teach the “guide wire,” as set forth in **independent claim 1**.

As readily seen from the above, when the Khosravi vascular filter 10 is placed in the vessel, the tubular member 12 is in the vessel while the bumper member 54 is still in the sheath 52, and thus the bumper member 54 and the tubular member 12 function differently, and they are completely discrete members which are independent from each other.

Further, the configuration of the struts and collar 30 as illustrated in Khosravi FIGS. 1, 2A, and 2B, bear no resemblance whatsoever with

“said crossed wire member comprising a plurality of spirally-configured wires, which cross each other, thereby forming an original configuration swollen in middle portion and tapered to the proximal and distal ends thereof under a normal condition ...

said crossed wire member being fixed at the proximal end thereof to said shaft and being slidably mounted at the distal end on said shaft.”

as set forth in **independent claim 1** and illustrated in FIG. 3 of the present application.

Regarding Brooks et al.

Brooks et al. FIGS. 1-5 disclose a distal protection device which includes a filter assembly of which the proximal ends 26, 46, 66, 94 are fixed to the guide wire 16, and the distal ends 24, 48, 68, 94 are fixed to the guide wire 16.

The Examiner argues that the filter assembly of Brooks can readily be used in Khosravi. However, the Examiner fails to explain how the fixed ends of Brooks et al. could result in only one end being fixed with the other end being movable.

In addition, it should be noted that the argument of the Examiner with reference to column 4, lines 24 to 27 of Khosravi is applicable only to the embodiment of the filter member wherein one end is fixed and the other end is movable. Khosravi never teaches that two fixed end could be changed to one end being fixed with the other end being movable.

Moreover, the struts 38 and 56 in Brooks et al. FIGS. 3 and 4 are not explicitly disclosed as being spirally-configured which cross each other, thereby forming an original configuration swollen in middle portion and tapered to the proximal and distal ends thereof

under a normal condition. As can be seen in FIG. 3, for example, it appears that strut 38 may simply undulate along one side of the assembly as it extends between fixed ends 46 and 48. FIG. 4 shows a similar configuration.

While the struts 90 in FIG. 5 are disclosed as being helical, they merely extend between apex 88 of the ring 84 and guide wire 86.

The configurations of the filter assemblies illustrated in Brooks et al. FIGS. 1-5 bear no resemblance whatsoever with

“said crossed wire member comprising a plurality of spirally-configured wires, which cross each other, thereby forming an original configuration swollen in middle portion and tapered to the proximal and distal ends thereof under a normal condition ...

said crossed wire member being fixed at the proximal end thereof to said shaft and being slidably mounted at the distal end on said shaft.”

as set forth in **independent claim 1** as previously presented.

As the Examiner knows well, a *prima facie* case of obviousness must be established in order for a rejection under 35 U.S.C. 103(a) to be proper.

M.P.E.P. section 2143 sets forth examples of basic requirements of a *prima facie* case of obviousness:

“The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*. The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been

obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.”

One of the exemplary rationales that may support a conclusion of obviousness in accordance with the *KSR* decision is set forth in M.P.E.P. 2143 (C). This exemplary rationale relates to “use of known technique to improve similar devices (methods, or products) in the same way.”

Referring to M.P.E.P. 21433 (C), the following is stated:

“To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

(1) a finding that the prior art contained a “base” device (method, or product) upon which the claimed invention can be seen as an “improvement;”

(2) a finding that the prior art contained a “comparable” device (method, or product that is not the same as the base device) that has been improved in the same way as the claimed invention;

(3) a finding that one of ordinary skill in the art could have applied the known “improvement” technique in the same way to the “base” device (method, or product) and the results would have been predictable to one of ordinary skill in the art; and

(4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that a method of enhancing a particular class of devices (methods, or products) has been made part of the ordinary capabilities of one skilled in the art based upon the teaching of such improvement in other situations. One of ordinary skill in the art would have been capable of applying this known method of enhancement to a “base” device (method, or product) in the prior art and the results would have been predictable to one of ordinary skill in the art.

The Supreme Court in *KSR* noted that if the actual application of the technique would have been beyond the skill of one of ordinary skill in the art, then using the technique would not have been obvious. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.” (*emphasis added*)

Regarding **item (1)** above, the Examiner appears to consider Khosravi as representing the prior art containing a “base” device upon which the claimed invention can be seen as an “improvement.”

As discussed above, the struts of Khosravi appear to linear members which bulge along the filter material 16 when the intermediate region 32 of the filter material 16 is expanded in a radial direction.

When the Khosravi vascular filter 10 is placed in the vessel, the tubular member 12 is in the vessel while the bumper member 54 is still in the sheath 52, and thus the bumper member 54 and the tubular member 12 function differently, and they are completely discrete members which are independent from each other.

Regarding **item (2)** above, the Examiner appears to consider Brooks et al. as representing the prior art containing a “comparable” device that has been improved in the same way as the claimed invention.

However, the Examiner fails to explain how the fixed ends of Brooks et al. could result in only one end being fixed with the other end being movable.

In addition, the argument of the Examiner with reference to column 4, lines 24 to 27 of Khosravi is applicable only to the embodiment of the filter member wherein one end is

fixed and the other end is movable. Khosravi never teaches that two fixed end could be changed to one end being fixed with the other end being movable.

The Applicant respectfully submits that the Examiner has failed to articulate at least **items (1) and (2)** above as is required.

In view of the above, the Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

At least for the reasons explained above, the Applicants respectfully submit that the combination of elements as set forth in **independent claim 1** is not disclosed or made obvious by the combination of prior art of record, including Khosravi and Brooks et al.

Therefore, **independent claim 1** is in condition for allowance.

Dependent Claims

The Examiner will also note that dependent claim 11 has been amended, and dependent claims 12-16 have been added to set forth additional novel features of the invention.

Regarding Dependent Claim 7 as Previously Presented.

On page 5 of the Office Action, the Examiner states that dependent claim 7 as previously presented “fails to disclose the slide ring assembly as comprising an inner ring and an outer ring with the wires sandwiched (and fixed) therebetween.” The Examiner then goes on to state “The above well know in the art statements are taken to be admitted prior art because applicant failed to traverse the examiner’s assertions (M.P.E.P. 2144.03).”

First of all, in each of the previous Amendments filed by the Applicants, the Applicants have traversed each of the rejections made by the Examiner.

Further, the Applicants hereby positively state that

1. "slide ring assembly as comprising an inner ring and an outer ring with the wires sandwiched between and fixed to said inner and outer rings," as set forth in dependent claim 7 (as previously presented) was not old and well known in the art at the time the present invention was made,
2. the Applicants do not admit that the statements made by the Examiner constitute admitted prior art,
3. the Applicants submit that one skilled in the art at the time the present invention was made would not consider the "slide ring assembly as comprising an inner ring and an outer ring with the wires sandwiched between and fixed to said inner and outer rings," to be an obvious variation of the Khoravi device, and,
4. the Applicants submit that the Examiner's rejection of dependent claim 7 is not proper and should be withdrawn.

Thus, **dependent claim 7** as previously presented should be allowable.

Regarding New Dependent Claim 16

Dependent claim 16 added herein recites

"wherein under the normal condition, the spirally-configured wires are tapered in a substantially equal manner at the proximal and distal ends thereof."

As can be seen in Brooks et al. column 4, lines 37-40 and FIG. 4, the struts 56 of the filter assembly basket 58 have a dense braid on the distal portion 60 (68) that transitions to a less dense braid on proximal portion 62 (66). FIG. 3 illustrates struts 38 having a similar configuration. As can be seen in each of FIGS. 3 and 4, the braids are not tapered substantially the same at each end.

Thus, **dependent claim 16** should be allowable.

All dependent claims are in condition for allowance due to their dependency from allowable independent claims, or due to the additional novel features set forth therein.

All pending claims are now in condition for allowance.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are respectfully requested.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. It is believed that a full and complete response has been made to the outstanding Office Action, and that the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone Carl T. Thomsen (Reg. No. 50,786) at (703) 208-4030 (direct line).

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time fees.

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Respectfully submitted,

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